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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Oscar SALONAHU et al.

RECEIVED

Group Art Unit: 2686

Serial No. 09/977,269

JAN 26 2005

Examiner: N. Mehrpour

Filed: October 12, 2001

Technology Center 2600

Atty. Docket No.: 59643-00071

For: METHOD FOR CONTROLLING TRANSMISSION POWER

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

January 13, 2005

Sir:

The Office Action dated October 14, 2004, has been received and carefully noted.

The following remarks are submitted as a full and complete response thereto.

The Office Action of October 14, 2004, included a restriction requirement, requiring election between one of the following two inventions:

Invention I, recited in claims 1-23, 26-37 and 39, drawn to a method/apparatus of controlling power wherein the first station transmits signals to a second station, by determining from the received power control command a parameter representative of the quality with which the power control is received at the first station; and

Invention II, recited in claims 24, 25 and 38, drawn to a method of a method/apparatus of controlling power wherein the first station transmits signals to a second station, by determining the received power control commands, combining the received values of the received power control commands, and controlling the power with which first station transmits to the second station based on the combined value..

Applicants respectfully elect, with traverse, to prosecute the subject matter of Invention I, recited in claims 1-23, 26-27 and 39, and drawn to a method/apparatus of controlling power wherein the first station transmits signals to a second station, by determining from the received power control command a parameter representative of the quality with which the power control is received at the first station. Applicants therefore respectfully request timely consideration on the merits.

Applicants also request reconsideration of the restriction requirement under 37 C.F.R. § 1.143. Applicants submit that the inventions, as claimed, are not distinct. As stated in the Office Action, Inventions I and II are related as combination and subcombination. In order to establish that combination and subcombination inventions are distinct, two-way

distinctness must be demonstrated. MPEP 806.05(c). Thus, inventions are distinct if it can be shown that a combination as claimed:

- (A) does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness), and
- (B) the subcombination can be shown to have utility by itself or in other and different relations.

Applicants submit the above factors are not met by the Office Action, and that the inventions are not distinct.

Invention I may be summarized, for example, by claim 1. Claim 1 recites a method of controlling the power with which a first station transmits signals to a second station. The method includes transmitting from the second station to the first station a power control command having a given value. The method also includes receiving the power control command at the first station. The method also includes determining from the received power control command a parameter representative of the quality with which the power control command is received at the first station. The method also includes controlling the power at which the first station transmits signals based on the determination step.

Invention II may be summarized, for example, by claim 24. Claim 24 recites a method of controlling the power with which a first station transmits signals to a plurality of second stations. The method includes transmitting from each of the second stations to the first

station a power control command having a given value. The method also includes receiving the power control commands at the first station. The method also includes determining the received values of the received power control commands. The method also includes combining the received values of the received power control commands. The method also includes controlling the power with which the first station transmits to the second station based on the combined value.

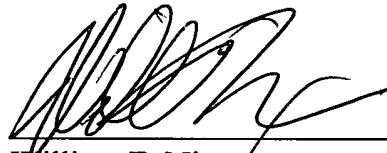
Applicants submit that the claims are different definitions of the same disclosed subject matter, vary in breadth or scope of definition, and disclose the same essential characteristics. The Office Action does not provide any evidence that the combination is patentable without the details of the subcombination. Inventions I and II both disclose controlling power from the first station to the second station dependent of a determination of one or more power control command values. Applicants submit that the relationship between the claims is such that the separately claimed subcombination constitutes the same essential distinguishing features of the combination. Specifically, the claims have the same essential features of using a power control command or commands at a first station, and controlling the power with which the first station transmits to a second station based on a value. According to claim 1, for example, the value may be a parameter based on the power control command and, according to claim 24, the value may be the combined value based on the power control commands. Thus, the claims recite the same patentable features of controlling

power from the first station to the second station dependent on a determination of one or more power control command values. Applicants submit that, for at least these reasons, Inventions I and II are not patentably distinct and that the restriction requirement is not proper. Applicants respectfully request that the restriction requirement be withdrawn.

Applicants reserve the right to file a divisional application on the non-elected claims at any point prior to the termination of the proceedings in the subject application.

In the event this paper is not being timely filed, the applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'William F. Nixon', is written over a horizontal line.

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